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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,573	10/25/1999	ALAN S. FISHER	20425.00510	2067

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N . 09/426,573	Applicant(s) FISHER ET AL.	
	Examiner JAGDISH N PATEL	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 8/12/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/426,573 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Response to Amendment***

2. Claims 15, 17, 20, 22 and 24 have been amended per request.

Proposed drawing changes and changes to the specification have been approved and entered as per request.

3. Rejection of claim 17 under 35 USC 112 (second) and claims 15-24 under 102(e) presented in previous office action have been withdrawn.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 15-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application

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being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 15, 18-20, 23 and 24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Jones et al (US Pat. 5,797,133, effective filing date Aug. 31, 1994) (hereafter referred to as Jones).

Claims 15 and 20. Jones discloses an update processing and transmission system and method (automatically determining the approval status of a potential borrower, abstract):

storage means, for storing status information in response to a commerce-related event (the (approval) status .... are stored on the hard drive of the data processor 5 at block 68 col. 6 L 30-49, Note: commerce-related event is loan processing by the data processor);

status information retrieval means for retrieving said status information (at steps 78, 80 and 70 shown in Fig. 2 and explained in col. 6 L 64- col. 7 L 37 in detail, processor retrieves the stored approval status, merges with a form letter, in order to create a notice letter);

message generation means for automatically generating a status message reflective of said status information (..creates a notice letter with appropriate wording.. describe the borrower's approval status, col. 6 L 64 – col. 7 L 8 );

message forwarding means for automatically forwarding said status message to a point where it may be accessed by an interested party (the notice letter is then automatically sent to the dealer blocks 78 and 80 Fig. 2, col. 7 L 9-13).

7. Claim 18, 19, 23 and 24. Status information is stored ... database within a first computer and ..separately storing database (Jones, col. 6 and 7 as discussed above in claim 1 analysis) .

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16, 17 and 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al.

Claims 16 and 21 Jones fails to teach that the status information relates to shipment of an item. However, the inventive concept disclosed by Jones, would be equally applicable to any consumer/business interaction where a need for automatically informing status of a commercial activity exists (e.g. ordering furniture at a department store with a predetermined delivery date/time and if there is a change in the status of the delivery date/time). In other words, storing status of a commercial activity and automatically generating a message reflective of the status information and automatically forwarding the message where the message may be accessed by an interested party as disclosed by Jones is also applicable to shipment of an item since no distinct features are recited in the claims 16 and 21 and their respective parent claim that separates loan status versus shipment status in that both activities pertain to a commerce related event.

10. Claims 17 and 22 recite components first computer and second computer, which in combination perform same function as processor 5 of the Jones system. Courts have held that making component separable that perform different functionality is common knowledge in the art (In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). In the instant claim(s) the reference teaches both elements (status information retrieval means and means that stores the status information database are contained in same processor 5, as discussed previously, col. 6 and 7). Since separating multiple functions performed by a computer into one or more computer to suite a desired

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application and business environment is a common knowledge in view of the cited court ruling, it would have been obvious to one of ordinary skill in the art at the time of invention to separate the retrieval means and the storage means for variety of reasons for example in a manner that the credit bureau provides credit analysis to many institutions who employ services of the credit bureau to check credit worthiness of their customers applying for credit. In this arrangement (a computer operated by) the credit bureau transmits (via a communication network) the status report regarding the credit application (approval or disapproval) to the (computer operated by) financial institution that in turn communicates to the customer.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

October 10, 2002